



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,090	06/30/2003	Jean-Marie Bernard	004900-195	8126

7590 09/02/2008
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
----------	--------------

1796

MAIL DATE	DELIVERY MODE
-----------	---------------

09/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/608,090	Applicant(s) BERNARD, JEAN-MARIE	
	Examiner Rabon Sergent	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-35 and 38-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-35 and 38-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 23-35 and 38-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, it is unclear how to interpret the amendment set forth within the last three lines of claim 23 (former claim 37), because it is unclear if the limitation pertains to the presence of additional monomeric isocyanate-containing or isocyanate-derived compounds or if it pertains to additional functional groups being present on the compound of formula (I). If the latter is the case, then, with the exception of the language pertaining to the mixture of thermolabile masking agents, it is unclear how this amendment further limits or defines the claim, since the “at least two isocyanate functions” language within the definition of “Iso” appears to already allow for the presence of additional isocyanate functions.

Secondly, it is unclear how to interpret the structure of claim 35, in view of the aforementioned amendment to claim 23. If the amendment pertains to additional monomers, then the formula is not representative of the claimed polyisocyanates of claim 37. If the amendment pertains to the presence of additional functions, then it is unclear where these functions are located on the claimed formula, if not present within “Iso”.

Thirdly, it is unclear how the claimed methods of claims 48 and 49 allow for the aforementioned amendment to claim 23. It is unclear if required steps have been omitted.

Lastly, claims 38-41 are indefinite, because they depend from cancelled claim 37.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1796

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 23-27, 30, 31, 33-35, 42, 45, 48, 50, 55, 56, and 59 are rejected under 35

U.S.C. 102(b) as being anticipated by EP 419114.

The reference discloses the reaction of polyisocyanates with cyclic carbonates having an isocyanate reactive substituent attached to the ring, and the use of the resulting product within polymers. See abstract and page 3, lines 1-8. Since reactants equivalent to those of applicant are being used within the reference, the position is taken that applicant's claimed polyisocyanate is inherently formed by the reaction within the reference. Applicant's response fails to conclusively establish that the polyisocyanates of the claimed structure are not encompassed by the reference. Applicant's amendment incorporating the subject matter of former claim 37 into claim 23 fails to overcome the rejection, because with respect to requiring the presence of additional isocyanate functions, the amendment appears to be no more limiting than the claimed definition of "Iso" (see remarks above within paragraph 1). Despite applicants' response, the position is maintained that the reference allows for the use of polyisocyanates that are greater than difunctional or even trifunctional (note the use of polymeric MDI at page 3, line 3 and Example 1).

4. The examiner regrets that these issues with respect to the subject matter of currently amended claim 23 or cancelled claim 37 have not been earlier presented. The examiner had previously interpreted the language of claim 37 as requiring the presence of additional monomeric species, as opposed to the presence of additional functions on the compound of formula (I); however, upon further review, the examiner now believes that such an interpretation is unwarranted. While the examiner takes the position that the language at issue is ambiguous, it

Art Unit: 1796

seems reasonable to conclude that the language likely pertains to the presence of functional groups on formula (I) as opposed to the presence of additional monomeric species.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1796

R. Sergent
August 28, 2008